

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Black et al.)
For: Method and Apparatus for)
Establishing Direct Mobile to)
Mobile Communication Between)
Cellular Mobile Terminals)
Serial No.: 10/614,231)
Filed: December 7, 2003)
Examiner: Dean, R.)
Art Unit: 2618)

Pre-Appeal Brief Request for Review

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants hereby request review of the final rejection in the above-identified application. No amendments are being filed with this request. The present request is being filed in conjunction with a notice of appeal. The review is being requested for the reasons stated below, which frames the issue to be considered as part of the pre-appeal review process.

The Examiner continues to reject claims 1-28. More specifically, the Examiner has rejected claims 1, 2, 11-21, 23 and 28 under 35 USC §102(e) as being anticipated by Mansour, US Patent Application Publication No. 2005/0085253, and rejected the remaining claims 3-10, 22 and 24-27 under 35 USC §103(a) as being unpatentable in view of Mansour, '253, and one or more of Hunzinger et al., US Patent Application Publication No. 2004/0116132; Tanaka, US Patent No. 6,819,919; Abdalgany et al., US Patent No. 6,584,090; and Abdalgany, US Patent No. 6,208,844.

However contrary to the Examiner's assertions, the relied upon references fail to make known or obvious each and every feature of the claims. Furthermore, the Examiner inappropriately relies upon portions of the principal reference that are not entitled to a filing date

that predates the present application. More specifically, Mansour, '253, claims priority from U.S. Provisional Application No. 60/511,118, which was filed on October 15, 2003. However the portions of Mansour, '253, namely paragraphs [0027], [0028] and [0038], which are relied upon in support of the rejection of at least the independent claims and indirectly each of the dependent claims which depend therefrom, are not present in the priority application, and therefore the relied upon portions are not entitled to the filing date (October 15, 2003) corresponding to the earlier filed priority application. In other words, the particular portions of the reference being relied upon in support of the rejection have an effective date for purposes of prior art that is no earlier than the filing date (May 25, 2004) of the later filed utility application, U.S. Patent Application Serial No. 10/852,212, which post dates the filing date (i.e. December 7, 2003) of the present application.

Nevertheless, as previously noted, the reference fails to make known each and every feature of the claims, in so far as the initiation of a call is facilitated through information conveyed over one or more paging channels, where the information conveyed by the paging channel comes through the base station (see [0006] and [0009]). The presence of a second paging channel is irrelevant, as the second paging channel continues to rely upon network infrastructure to relay communication initiation information, such as a communication initiation sequence, where the communication initiation sequence is received by the network, and a page is then formulated by the network, and is provided to the target (i.e. call destination) mobile terminal, via the network infrastructure as part of the broadcast paging channel. Such a teaching precludes the second cellular mobile terminal from detecting the communication initiation sequence, which is transmitted by the first cellular mobile terminal (claim 1).

Furthermore, a walkie talkie type call corresponding to a Nextel Direct Connect feature, often alternatively referred to as Push to Talk, still routes the actual communication via the network infrastructure, where a separate communication channel is assigned for communication between each of the mobile terminals and the network infrastructure, for each of transmission and reception of a wireless signal, and the communication channels from which each of the mobile terminals are assigned for transmission are associated with a different set of frequencies, than the frequencies from which the communication channels for reception for each of the mobile terminals are assigned. In other words, the network infrastructure uses a different set of frequencies for selecting communication channels for transmitting a communication signal to a

mobile terminal, than the set of frequencies for selecting communication channels for receiving a communication signal from a mobile terminal. Furthermore, a different communication channel is selected for each of the different mobile terminals with which the network is communicating. Nextel Direct Connect does not function any differently. Furthermore, the cited reference fails to teach or suggest that the same frequency is used for both transmitting and receiving, in either the portion of the reference entitled to the earlier filing date associated with the Provisional Application, or the portion of the reference that is not entitled to the earlier filing date and therefore does not constitute a prior teaching. As a result, contrary to the assertions of the Examiner, Mansour, '253, minimally fails to teach or suggest at least one of the cellular transmitter and the cellular receiver, which functions at a frequency of operation, corresponding to the other one of the cellular transmitter and the cellular receiver, and therefore fails to teach or suggest each and every feature of independent claim 23.

The above noted deficiencies relative to independent claims 1 and 23 are neither taught nor suggested by the other cited references relied upon in support of any of the rejections.

To the extent that each and every feature of independent claims 1 and 23 have been identified as not being taught or suggested by the cited references, and to the extent that most if not all of the relied upon teachings of Mansour, '253, have not been shown to have a date of prior art effect that predates the present application, the present rejection has not been properly supported relative to the independent claims, as well as any of the claims which depend therefrom (i.e. claims 2-22 and 24-28).

In view of the above remarks, the applicants would respectfully request that the Examiner's final rejection of the claims be withdrawn, as failing to make known or obvious each and every feature of the claims, and/or as being improperly relied upon as a prior teaching.

Respectfully submitted,

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